



Atty. Dkt. No. 074273-0195

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hiroyuki TOBA
Title: MOBILE COMMUNICATION TERMINAL WITH
EXTERNAL DISPLAY UNIT
Application No.: 10/090,792
Filing Date: 03/08/2002
Examiner: S. Q. Aminzay
Art Unit: 2684

RECEIVED

SEP 03 2004

Technology Center 2600

INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith on Form PTO/SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR §1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR §1.97 and §1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The listed documents are being submitted in compliance with 37 CFR §1.97(c), before the mailing date of either a final action under 37 CFR §1.113, a notice of allowance under 37 CFR §1.311, or an action that otherwise closes prosecution in the application.

RELEVANCE OF EACH DOCUMENT

Any document listed on the attached PTO/SB/08 was cited as being relevant during the prosecution of the corresponding Japanese application. Items of information A1, and A5 are U.S. patents that are counterparts to item of information A7; item of information A2 is a U.S. patent that is a counterpart to item of information A11; item of information A3 is a U.S. patent that is a counterpart to item of information A12; and item of information A4 is a U.S. patent that is a counterpart to item of information A8. . The absence of a translation or an English-language counterpart document does not relieve the PTO from its duty to consider any submitted document (37 CFR §1.98 and MPEP§609).

A translation of a portion of a Japanese Office Action that issued August 3, 2004 with respect to a counterpart Japanese patent application is provided below.

“(Reason 1)

The inventions related to the following claims of the present application could have been easily invented by a person with ordinary knowledge of technology in the field to which the invention belongs prior to the filing of this application based on the inventions recited in the publications below, which had been distributed in Japan or abroad prior to the filing of this application, and therefore cannot receive a patent according to the stipulations of Article 29, Paragraph 2 of the Japan Patent Law.

Note

(For the list of the cited literature, see the List of Cited Literature)

Regarding Claims 1, 4, and 5, Cited Literature 1 and 2

Cited Literature 1 describes a mobile communications terminal equipped with a folder switch for sensing the open/closed state thereof, a first liquid crystal display device, which cannot be seen when the folder cover is closed (when in a folded state), and a second liquid crystal display device, which can be seen in said state, wherein, when an incoming signal is detected when the folder cover is closed, caller information is displayed on the second liquid crystal display device. (See Paragraphs (0064)–(0065), and (0079).)

The same technology is disclosed in Cited Literature 2, as well. (See (Claim 4) and Paragraphs (0016) and (0041).)

Regarding Claims 2 and 3, Cited Literature 1 and 2

Because, as displays relating to incoming calls, information such as there having been an incoming call [when the owner of the telephone] was not present and the times of incoming calls are typical items, being able to display these typical items on the second display unit in the inventions described in Cited Literature 1 and 2 is something which could be easily arrived at by one skilled in the art.

Regarding Claim 6, Cited Literature 1, 2, 4, and 5

Providing displays for a plurality of items (for example, a scroll display), is also a common item. (See, for example, Paragraphs (0026) and (Figure 3) in Cited Literature 4, and (Figure 7) in Cited Literature 5.)

Regarding Claims 7, 8, 10, and 13, Cited Literature 2 and 3

Cited Literature 2 describes displaying the caller ID and message data in a viewable display region, even when [the device] is in a folded state. (See Paragraph (0041).)

Similarly, Cited Literature 3 describes displaying simple mail contents in a viewable region part (the see-through liquid crystal display part 10), even when [the device] is in a folded state. (See (Claim 1) and Paragraphs (0025) and (0026).)

Regarding Claims 9, 11, and 12, Cited Literature 2 and 3

When it comes to displaying mail, displaying the mail address of the sender, the date and time of reception, and the text is only that which is performed typically, and so being able to display these typical items when displaying on the second display unit in the inventions according to Cited Literature 2 and Cited Literature 3 is something which could be envisioned easily by one skilled in the art.

Regarding Claims 14–17, Cited Literature 2, 3, 4, and 5

The same as the indications for Claim 6.

(Reason 2)

The inventions related to the following claims of the present application are the same as the inventions initially described in the specification or in the drawings of the patent applications below, for which application had been made prior to the application date for the present application, and which were published after the application date for the present application, and the inventors of the present application are not the same as the inventors of the aforementioned application which had been made prior to the application date for the present application, and, additionally, the applicant at the time of the present application is not the same as the applicant of the aforementioned prior application, and therefore cannot receive a patent according to the stipulations of Article 29, Paragraph 2 of the Japan Patent Law.

Note

(For a list of the cited literature, see the List of Cited Literature)

Regarding Claims 1, 2, 3, and 6, Prior Application: 1

Prior Application 1, in the initial specification, etc., describes a sub-display device that displays a plurality of simple information when [the device] is in a folded state, wherein, when an incoming voice call has not been answered, the display displays the time of the incoming calls and the number of incoming calls. (See Paragraph (0049) and Figure 3.)

Regarding Claims 7, 8, 12, and 14, Prior Application 1

Prior Application 1, in the initial specification, etc., describes a sub-display device that displays a plurality of simple information when [said device] is in a folded state, wherein, when displaying information pertaining to the reception of e-mail, said device

displays the timing of the reception and the number of [e-mails] received. (See Paragraph (0050) and Figure 3.)

Regarding Claims 7, 8, 9, 12, and 15–17, Prior Application 2

Prior Application 2, in the initial specification, etc., describes a foldable mobile terminal device with a first display unit (corresponding to the "second display unit" in the present application) on the outside surface of a sub-body, and a second display unit on the inside surface of said sub-body, wherein the time at which messages were received, and the telephone number of the sender (or caller) are displayed on said first display unit, and [said display] can be scrolled using key operations. (See Claims 1, 2, and 6.)

If new reasons for rejection are discovered, notification will be made of the reasons for rejection.

List of Cited Literature

1. Japanese Unexamined Patent Application Publication 2001-067049
2. Japanese Unexamined Patent Application Publication H11-017579
3. Japanese Unexamined Patent Application Publication 2000-253113
4. Japanese Unexamined Patent Application Publication 2000-023255
5. Japanese Unexamined Patent Application Publication 2000-022788
6. Japanese Patent Application 2000-291152 (Japanese Unexamined Patent Application Publication 2002-101160) (Defined as "Prior Application 1.")
7. Japanese Patent Application 2001-275541 (Japanese Unexamined Patent Application Publication 2002-232531) (Defined as "Prior Application 2.")

Applicant's statements regarding the Japanese Office Action are based on a partial translation that Applicant's representative obtained. These statements

should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Japanese Office Action.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

STATEMENT

The undersigned hereby states in accordance with 37 CFR §1.97(e)(1) that each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to filing of this Statement.

The undersigned hereby states in accordance with 37 CFR §1.704(d) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in 37 CFR §1.56(c) more than thirty days prior to the filing of the information disclosure statement..

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

September 2, 2004
Date

Phillip J. Articola
Phillip J. Articola
Registration No. 38,819

FOLEY & LARDNER LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

Date Submitted: September 2, 2004

Use as many sheets as necessary

Sheet 1 of 1

Complete if Known

Application Number	10/090,792
Filing Date	03/06/2002
First Named Inventor	Hiroyuki TOBA
Group Art Unit	2684
Examiner Name	S. Q. Aminzay
Attorney Docket Number	074273-0195

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
	A1	6,125,286		JAHAGIRDAR et al	09/26/2000	RECEIVED SEP 03 2004 Technology Center 2600
	A2	2002/0037754		HAMA et al.	03/28/2002	
	A3	2002/0094826		LEE	07/18/2002	
	A4	6,466,202		SUSO et al.	10/15/2002	
	A5	6,304,763		JAHAGIRDAR et al.	10/16/2002	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Documents	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Office ³	Number ⁴	Kind Code ⁵ (if known)				
	A6	JP	2001-67049			03/16/2001		ABS
	A7	JP	11-17579			01/22/1999		ABS
	A8	JP	2000-253113			09/14/2000		ABS
	A9	JP	2000-23255			01/21/2000		ABS
	A10	JP	2000-22788			01/21/2000		ABS
	A11	JP	2002-101160			04/05/2002		ABS
	A12	JP	2002-232531			08/16/2002		ABS

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶

Examiner
SignatureDate
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.